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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,615	02/27/2004	Henry Earl Finley	23 - 0692	9079
40158	7590	05/13/2005	EXAMINER	
LEONARD & PROEHL, PROF. L.L.C. 3500 SOUTH FIRST AVENUE CIRCLE SUITE 250 SIOUX FALLS, SD 57105			REESE, DAVID C	
		ART UNIT		PAPER NUMBER
				3677

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/789,615	FINLEY, HENRY EARL
	Examiner David C. Reese	Art Unit 3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 February 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-9 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 27 February 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/27/2004

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Status of Claims

[1] Claims 1-9 are pending.

Drawings

[2] The drawings are objected to under 37 CFR 1.83(a) because they fail to show reference numeral 10 as described in the specification (or it is a numbering error in the specification, in which case disregard this objection, and fix the specification accordingly). Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

[3] Claim 2 is objected to because of the following informalities: “couplable” is not a word, consider, “coupled” instead. Appropriate correction is required.

Claim Rejections - 35 USC § 102

[4] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[5] Claims 1-4, 6-8 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Kohler, US-2,490,908, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 1, Kohler teaches of an ear adornment for adorning an ear of a user, the ear adornment comprising:

a frame member (b) being adapted for selectively engaging the ear of the user (Fig. 2); and

a sleeve member (a) being selectively coupled to said frame member (a onto b as shown in Fig. 1) such that said sleeve member (a) is adapted for being positioned adjacent the ear of the user when the frame member engages the ear of the user (Fig. 2), said sleeve member (a) being adapted for providing the user with a unique appearance when said sleeve member is coupled to said frame member.

Examiners note: it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re: Claim 2, further comprising:

said frame member (b) comprising a pair of engaging portions (15, 17), each of said engaging portions being adapted for extending around a portion of the ear (via 16 in Fig. 2) of the user such that each of said engaging portions extends from a front of the ear to a rear of the user (Fig. 2), said sleeve member (a) being couplable to said engaging portions (15, 17) of said

frame member (b) such that said sleeve member (a) extends between said engaging portions (15, 17).

Re: Claim 3, further comprising:

each of said engaging portions (15, 17) comprising a resiliently flexible material, said resiliently flexible material being adapted for permitting each of said engaging portions (15, 17) to substantially conform to a general shape of the ear when each of said engaging portions (15, 17) extends from the front to the back of the ear (Fig. 2).

Re: Claim 4, further comprising:

said frame member (b) comprising a pair of alignment portions (14, 19), each of said alignment portions being coupled to one of a pair of free ends of each of said engaging portions (15, 17) such that one of said alignment portions (14, 19) is positioned adjacent the front of the ear of the user and the other of said alignment portions is positioned adjacent the rear of the ear of the user (Fig. 2), said alignment portions maintaining alignment of said engaging portions when said engaging portions are extending around the ear of the user (Fig. 2).

Re: Claim 6, further comprising:

said sleeve (a) member comprising a perimeter wall (11), said perimeter wall (11 through 18) defining a receiving bore (inside of 18) extending through said sleeve (a) member, said receiving bore (inside of 18) selectively receiving at least a portion of said frame member (17) such that said sleeve member (a) is selectively coupled to said frame member (b), said sleeve member being adapted for being displayed on the ear of the user when said frame member engages the ear of the user (Fig. 2).

Re: Claim 7, further comprising:

said sleeve member (a) comprising a flexible material, said flexible material permitting said sleeve member to conform to the portion of said frame member received by said sleeve member when said sleeve member receives said frame member (Figs. 1 and 5).

Re: Claim 8, further comprising:

an adornment member (20) being selectively coupled to said sleeve member (20) onto (a) via 23, see lines 29-41 in column 2), said adornment member (20) being suspended from said frame member (b) when said sleeve member (a) is coupled to said frame member (b), said adornment member (20) being adapted for adorning the ear of the user when said frame member engages the ear of the user (Fig. 2).

Claim Rejections - 35 USC § 103

[6] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[7] Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohler, US- 2,490,908, in view of Zubalik, US 2,803,953.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 5, Kohler teaches of the above claims.

However, Kohler fails to disclose expressly that the ear adornment is held in place by magnetic attraction.

Zubalik teaches of an earring that provides means whereby the earrings are held in place by magnetic attraction.

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the mechanical ear adornment as taught by Kohler, to incorporate an embodiment as taught by Zubalik, in order to as Zubalik states in column 1, "It is an object of this invention to provide an earring which may be accommodated to a non-pierced ear and which does not utilize either a hook or a clamp or other type of mechanical clamping elements." Continuing with column 2, line 33, "Aside from presenting unsightly impedimenta, these clamping means are frequently irritating to the ear. The magnetic members forma comfortable..." Thus it is obvious to discern why one would prefer to use magnets instead of other mechanical means.

As for Claim 9, Kohler teaches of an ear adornment for adorning an ear of a user, the ear adornment comprising:

a frame member (b) being adapted for selectively engaging the ear of the user (Fig. 2);
a sleeve member (a) being selectively coupled to said frame member (a onto b as shown in Fig. 1) such that said sleeve member (a) is adapted for being positioned adjacent the ear of the user when the frame member engages the ear of the user (Fig. 2), said sleeve member (a) being

adapted for providing the user with a unique appearance when said sleeve member is coupled to said frame member;

 said frame member (b) comprising a pair of engaging portions (15, 17), each of said engaging portions being adapted for extending around a portion of the ear (via 16 in Fig. 2) of the user such that each of said engaging portions extends from a front of the ear to a rear of the user (Fig. 2), said sleeve member (a) being couplable to said engaging portions (15, 17) of said frame member (b) such that said sleeve member (a) extends between said engaging portions (15, 17);

 each of said engaging portions (15, 17) comprising a resiliently flexible material, said resiliently flexible material being adapted for permitting each of said engaging portions (15, 17) to substantially conform to a general shape of the ear when each of said engaging portions (15, 17) extends from the front to the back of the ear (Fig. 2).

 said frame member (b) comprising a pair of alignment portions (14, 19), each of said alignment portions being coupled to one of a pair of free ends of each of said engaging portions (15, 17) such that one of said alignment portions (14, 19) is positioned adjacent the front of the ear of the user and the other of said alignment portions is positioned adjacent the rear of the ear of the user (Fig. 2), said alignment portions maintaining alignment of said engaging portions when said engaging portions are extending around the ear of the user (Fig. 2);

 said frame member comprising a pair of magnetic members, one of said magnetic members being coupled to one of said alignment members such that the other one of said magnetic members is coupled to the other one of said alignment members, one of said magnetic members magnetically attracting the other one of said magnetic members such that said magnetic

members gently compress the ear between said magnetic members to maintain positioning of said frame member when said frame member engages the ear of the user (substitution of magnetic means as taught by Zubalik for the ends of the alignment members of Kohler);

 said sleeve (a) member comprising a perimeter wall (11), said perimeter wall (11 through 18) defining a receiving bore (inside of 18) extending through said sleeve (a) member, said receiving bore (inside of 18) selectively receiving at least a portion of said frame member (17) such that said sleeve member (a) is selectively coupled to said frame member (b), said sleeve member being adapted for being displayed on the ear of the user when said frame member engages the ear of the user (Fig. 2);

 said sleeve member (a) comprising a flexible material, said flexible material permitting said sleeve member to conform to the portion of said frame member received by said sleeve member when said sleeve member receives said frame member (Figs. 1 and 5);

 an adornment member (20) being selectively coupled to said sleeve member (20) onto (a) via 23, see lines 29-41 in column 2), said adornment member (20) being suspended from said frame member (b) when said sleeve member (a) is coupled to said frame member (b), said adornment member (20) being adapted for adorning the ear of the user when said frame member engages the ear of the user (Fig. 2).

Conclusion

[8] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

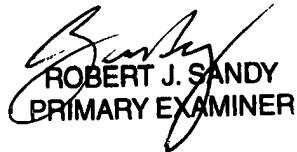
The following patents are cited further to show the state of the art with respect to this particular type of ear attachment; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: please see submitted notice of reference cited.

[9] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Examiner
Art Unit 3677


ROBERT J. SANDY
PRIMARY EXAMINER